

REMARKS

Reconsideration and allowance of the present application are respectfully requested in the view of the above-identified claim amendments in conjunction with the following remarks. Claims 1-6, 8-10, 12-19, 38-46, 49, and 50 are currently pending in this application.

Regarding the Cancellation of Previously Withdrawn Claims

The claims that were previously withdrawn in this case (i.e., claims 20-37 and 48) have now been canceled. The cancellation of these claims is without prejudice or disclaimer. It is the present intention of the Applicant to file one or more divisional applications to pursue these canceled claims.

Regarding the Amendments to the Claims

To clarify the record, the Applicant has amended claim 1 to address the 35 U.S.C. § 101 rejection and the 35 U.S.C. § 112, second paragraph, rejection (both to be discussed below). The Applicant has independently made other minor changes to claim 1 and other claims to improve the clarity of these claims. The Applicant has made no amendments in response to the Office Action's 35 U.S.C. § 103 rejections (to be discussed below).

Regarding the 35 U.S.C. § 101 Rejection

The Office Action rejects claims 1-6, 8-10, 12-19, and 38-47 as failing to comply with the provisions of 35 U.S.C. § 101 "because the claimed invention is directed to non-statutory subject matter" (paragraph No. 7 of page 3 of the Office Action). Namely, the Office Action states that "Software by itself is considered non-statutory" (paragraph No.

1 7 of page 3 of the Office Action). Applicant respectfully traverses this rejection for the
2 following reason.

3 MPEP § 2106 (page 2100-13 of the Rev. 2, May 2004 revision) states that
4 “computer programs claimed as computer listings *per se*, i.e., the descriptions or
5 expressions of the programs, are not physical ‘things,’” and, as such, programs are
6 “neither computer components nor statutory processes, as they are not ‘acts’ being
7 performed.”

8 However, in the present case, claim 1 is directed to a “system” that comprises
9 *inter alia* an information tracking component, a supply component, a publishing
10 component, and a subscriber component. Later claims recite additional physical
11 elements, such as various databases. These claims cannot reasonably be construed as
12 disembodied computer code, as mere code cannot, by itself, perform the acts recited in
13 the claims. Moreover, the Patent Office has provided no authority to support its position
14 that the above-described type of subject matter can reasonably be construed as a
15 “computer listing *per se*,” as proscribed by MPEP § 2106.

16 Nevertheless, to expedite prosecution of this case toward allowance, the Applicant
17 has amended claim 1’s preamble to recite a “system having one or more computing
18 devices.” Exemplary support for this amendment can be found at least on page 4, lines 6-
19 16, and page 32, lines 22-28 of the specification. The Applicant submits that this change
20 indisputably distinguishes what is being claimed from a disembodied listing of program
21 code. For instance, MPEP § 2106 (page 2100-13 of the Rev. 2, May 2004 revision)
22 states: “When a computer program is recited in conjunction with a physical structure,
23 such as a computer memory, Office personnel should treat the claim as a product claim.”

24 For the above-identified reasons, the Applicant submits that claim 1 recites
25 statutory subject matter. Claims 2-6, 8-10, 12-19, and 38-46 incorporate the above-

described added element of claim 1 through dependency, and therefore likewise recite statutory subject matter. For at least the above-stated reasons, the Applicant respectfully requests the Patent Office to withdraw the 35 U.S.C. § 101 rejection.

Regarding the 35 U.S.C. § 112, First Paragraph, Rejection.

Claims 1-6, 8-10, 12-19, and 38-47 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement of that statute. Applicant respectfully traverses this rejection for the following reasons.

The Office Action states that “Applicants have not disclosed ‘the publishing component transferring the information to subscribers in advance of receiving the requests from the subscribers . . .’” (paragraph No. 9 on pages 3 and 4 of the Office Action). The Office Action elaborates by stating:

Additionally, Applicants’ italicized portion of the specification on page 18 of their arguments [in the previously submitted Remarks] expressly states that the information is communicated which is ‘based on the subscriber criteria . . .’” Unlike claim 1 which requires ‘transferring the information to subscribers in *advance of* receiving requests from subscribers,’ the section of the specification is providing content *in response to or after* the user’s criteria is received. In other words, the claims require the information be transfer [sic] to the subscriber ‘in advance of’ receiving their requests while the specification teaches that the information is provided only *after* receiving their requests. The Examiner interprets the user’s selection of criteria as a request. This [sic] two positions are mutually exclusive. For this reason alone, Applicant’s arguments not persuasive.” (paragraph No. 21 on page 9 of the Office Action).

1 It is useful to revisit the language of claim 1 *because the Patent Office is not*
2 *quoting the pertinent parts in that claim in full:*

3
4 1. A system having one or more computing devices, comprising:

5 an information tracking component configured to store, for each of a plurality of
6 items, information describing the item;

7 a supply component configured to receive data describing the plurality of items and
8 store the data as the information in the information tracking component;

9 a publishing component configured to select, based on pre-established selection
10 criteria, for each of a plurality of subscribers, a set of information from the information
11 tracking component, and to *communicate the selected set of information to local storage*
12 *maintained by the subscriber, wherein the publishing component is configured to perform*
13 *the communication by transferring the information to subscribers in advance of receiving*
14 *requests from the subscribers to modify the information; and*

15 a subscriber request component configured to receive requests from the plurality of
16 subscribers and modify the information stored in the information tracking component in
17 accordance with the requests,

18 wherein the publishing component is further configured to identify one or more of
19 the plurality of subscribers affected by the modification to the information stored in the
20 information tracking component, and to communicate, to the one or more of the plurality of
21 subscribers affected by the modification, the information as modified.

22
23 As indicated in the passages in italicized bold above, the claim recites that the
24 publishing component communicates “the selected set of information to local storage
25 maintained by the subscriber.” The claim qualifies this communication by stating that the

1 publishing component transfers the “information to subscribers in advance of receiving
2 requests from the subscribers *to modify the information.*” Accordingly, the claim does
3 not simply state that the publishing component transfers the “information to the
4 subscribers in advance of receiving requests from the subscribers” (as quoted in the
5 Office Action), but expressly states *that these requests from subscribers are to “modify*
6 *the information.*” When the claim is read in its entirety, it is immaterial whether the
7 Patent Office is interpreting the “user’s selection of criteria as a request,” because, in any
8 event, this kind of selection is *not* a request to “modify the information” that has been
9 transferred to the user. In other words, the recited request is a request to modify the
10 information, not a generic request which the Patent Office is free to interpret as any
11 communication with the system. Hence, there is no contradiction in the claim when the
12 claim is read as a whole.

13 There is likewise plain and unambiguous support in the specification for claim 1.
14 Note, for instance, Fig. 7 and the accompanying discussion on page 25 of the
15 specification. These portions of the specification describe, with complete clarity, that the
16 publication component 110 transfers information to a subscriber (in step 704) in advance
17 of the subscriber generating a request to change the information (in step 708). More
18 specifically, step 704 obviously occurs before, or, in other words, “in advance of,” step
19 708.

20 For the above-identified reasons, the Applicant submits that the 35 U.S.C. § 112,
21 first paragraph, rejection is groundless, and respectfully requests that it be withdrawn.

22
23 *Regarding the 35 U.S.C. § 112, Second Paragraph, Rejection*

24 Claims 1-6, 8-10, 12-19 and 38-47 were rejected under 35 U.S.C. § 112, second
25 paragraph, as failing to particularly point out and distinctly claim the subject matter

1 which Applicant regards as the invention. Applicant respectfully traverses this rejection
2 for the following reasons.

3 Paragraph No. 11 of the Office Action enumerates three bases for rejecting the
4 claims under 35 U.S.C. § 112, Second Paragraph, labeled as items (a), (b), and (c).

5 As to item (a), the Patent Office states that the phrases "one or more items" and
6 "plurality of items" within claim 1 are vague. In response, the Applicant has amended
7 claim 1 in a manner which is believed to improve the clarity of the phrases in question.

8 As to item (c), the Patent Office states that it is unclear which of the statutory
9 classes of invention the claims are drawn to. The amendments made to the claims in
10 response to the 35 U.S.C. § 101 rejection should clarify that claim 1 does not encompass
11 a proscribed listing of code *per se*. The amendments further make it clear that the
12 invention would be categorized as a product-type claim.

13 As to item (b), the Patent Office states that the claim 1 does not clearly
14 demonstrate whether Applicant intends to claim software only, a combination of software
15 and hardware, or just software. As to the precise manner in which the components
16 recited in claim 1 are implemented, that is a matter of breadth, not an issue of clarity.
17 The specification makes it abundantly clear that the system can be implemented in a
18 variety of ways (e.g., note at least page 32, lines 22-28), and the claims recite the
19 invention with a degree of generality which is consistent with the specification. As
20 expressly stated by MPEP § 2173.04, "Breadth of a claim is not to be equated with
21 indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of
22 the subject matter embraced by the claims is clear, and if applicants have not otherwise
23 indicated that they intend the invention to be of a scope different from that defined in the
24 claims, then the claims comply with 35 U.S.C. 112, second paragraph."
25

For the above-identified reasons, the Patent Office is respectfully requested to withdraw the 35 U.S.C. § 112, second paragraph, rejection.

Regarding the 35 U.S.C. § 103(a) Rejections

Claims 1-6, 8-10, 12-19, and 38-47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,615,253 to Bowman-Amuah (referred to as "Bowman-Amuah" for brevity below). Claims 1-6, 8-10, 12-19, and 38-47 are also rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,567,846 to Garg et al. (referred to as "Garg" for brevity below). The Applicant respectfully traverses both of these rejections for the following reasons.

For convenience of reference, claim 1 is again repeated in full below (with emphasis added):

1. A system having one or more computing devices, comprising:
 - an information tracking component configured to store, for each of a plurality of items, information describing the item;
 - a supply component configured to receive data describing the plurality of items and store the data as the information in the information tracking component;
 - a publishing component configured to select, based on pre-established selection criteria, for each of a plurality of subscribers, a set of information from the information tracking component, and to communicate the selected set of information to local storage maintained by the subscriber, wherein the publishing component is configured to perform the communication by transferring the information to subscribers in advance of receiving requests from the subscribers to modify the information; and

a subscriber request component configured to *receive requests from the plurality of subscribers and modify the information stored in the information tracking component in accordance with the requests,*

wherein the publishing component is further configured to *identify one or more of the plurality of subscribers affected by the modification to the information stored in the information tracking component, and to communicate, to the one or more of the plurality of subscribers affected by the modification, the information as modified.*

Considering the Bowman-Amuah document first, this is an enormously lengthy patent (having 310 columns of text and 195 figures). It is unclear what portion of this document the Patent Office is relying on in making the rejection, as the Office Action does not include column and line number citations. Moreover, the Office Action appears to paraphrase this reference. The Office Action specifically characterizes Bowman-Amuah reference as follows:

Bowman-Amuah '253 discloses publishing information to the various users using 'push' technology prior to the user requesting the content. In particular Bowman-Amuah '253 pushes a large set of content (including the content in which the user wants to receive) and then limiting or selecting a subset of that content based upon the particular user's desires. (paragraph No. 13 on page 5 of the Office Action)

Although presently unclear, it appears that this description is a paraphrasing of Bowman-Amuah's abstract. The subject matter in Bowman's abstract, in turn, is best described in column 243, line 11 to column 244, line 59, and is shown in Figs. 116-120. These portions describe a method in which a total amount of data required for an

1 application executed by a client is determined. Then, in a single call, the total amount of
2 data is requested from a server over a network. All of the data is bundled into a data
3 structure by the server in response to the single call. The bundled data structure is sent to
4 the client over the network and data of the data structure is cached on the client. The
5 cached data of the data structure is used as need during execution of the application on
6 the client. Note particularly column 243, lines 12-25.

7 This subject matter does not even remotely resemble what is being recited in
8 claim 1. For instance, Bowman-Amuah's server downloads data to a client, but there is
9 no indication that, after receipt of this data, that Bowman includes a provision for
10 receiving client requests to modify the information, and that the server, in turn,
11 communicates the modified information to affected clients. Hence, among other
12 deficiencies, Bowman-Amuah does not suggest at least the bolded and italicized portions
13 of claim 1 above, in the context of the claim as read as a whole.

14 As to the Office Action's general reference to "push technology," this technology
15 as summarized in <<http://en.wikipedia.org/wiki/Push_technology>> as follows:

16
17 Push technology, also called server push, describes an internet-based content
18 delivery system where information is delivered from a central server to a client computer
19 based upon a predefined set of request parameters outlined by the client computer.
20 Illustratively a client computer such as a desktop home user would subscribe to various
21 information topics provided by a content provider and as that content is created by the
22 content provider, such information is "pushed" or delivered across the internet to the desktop
23 home user and displayed on that users computer.

24 The technology first gained popularity in the 1990s using PointCast software. It got
25 a lot of media attention and both Netscape and Microsoft integrated it heavily into their

software at the height of the browser wars. However, most people didn't find push technology useful, and it later faded into more obscure corners of software packages.

Bowman-Amuah also summarizes push technology in column 108, lines 15-49.

The invention recited in claim 1 is not rendered obvious by push technology. Push technology is basically a filtering mechanism for automatically sending content to a user from a server system. But this technology does not include provisions for allowing a client to modify received content; nor does this technology include provisions for disseminating such modified content to other clients that have received the original content. Hence, push technology does not disclose at least the bolded and italicized elements of claim 1, when read in the context of claim 1 as a whole.

For at least the above-stated reasons, the Applicant submits that Bowman-Amuah does not render the subject matter of claim 1 obvious. The remaining rejected claims depend from claim 1; by virtue of such dependency, these claims likewise distinguish over Bowman-Amuah. Thus, the Applicant respectfully requests the Patent Office to withdraw the § 103 rejection of the claims based on Bowman-Amuah.

Turning now to the Garg reference, it is again unclear what specific portion of this reference that the Patent Office is relying on making the rejection. For instance, the Office Action applies its description of Bowman-Amuah to also characterize the Garg reference, without citing column and line numbers to identify the portions of Garg being relied upon.

Although presently unclear, it is possible that the Office Action is relying on Garg's discussion of push technology in column 4, lines 17-56. However, push technology does not describe the invention recited in claim 1 for at least the reasons cited above with respect to Bowman-Amuah. Moreover, Garg describes push technology as

1 problematic in column 4, lines 41-56. As such, if one having ordinary skill in the art
2 sought to expand or modify Garg's system in any manner, the Garg reference itself would
3 actually teach away from incorporating push-like elements into the design.

4 For at least the above-stated reasons, the Applicant submits that Garg does not
5 render the subject matter of claim 1 obvious. The remaining rejected claims depend from
6 claim 1; by virtue of such dependency, these claims likewise distinguish over Garg.
7 Thus, the Applicant respectfully requests the Patent Office to withdraw the § 103
8 rejection of the claims based on Garg.

9 In closing, the 35 U.S.C. § 103 rejections appear to distill the invention down to
10 what the Patent Office perceives as the "gist" of the invention. This approach is
11 misplaced in at least two regards. First, the Office's understanding of what the claim
12 recites is at odds with what the claim actually states. Second, it is procedurally in error to
13 distill the invention down to a general theme, rather than address the specific elements
14 recited in the claims. As stated in MPEP § 2143.03, "To establish prima facie
15 obviousness of a claimed invention, all the claim limitations must be taught or suggested
16 by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." Further, as
17 stated in MPEP § 2141.02, "Distilling an invention down to the 'gist' or 'thrust' of an
18 invention disregards the requirement of analyzing the subject matter 'as a whole.' *W.L.*
19 *Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983),
20 *cert. denied*, 469 U.S. 851 (1984).

21 *If the rejections are repeated in any form, the Patent Office is respectfully*
22 *requested to assist the Applicant (and, if the case advances to appeal, the Board of*
23 *Appeals) by addressing the express elements recited in the claims, pointing out where*
24 *these elements are allegedly disclosed in the applied art.* (Note 37 C.F.R. § 1.104:
25 "When a reference is complex or shows or describes inventions other than that claimed

1 by the applicant, the particular part relied on must be designated as nearly as practicable.
2 The pertinence of each reference, if not apparent, must be clearly explained and each
3 rejected claim specified.” The fact that the Bowman-Amuah patent has 310 columns of
4 text would appear to qualify it as complex.) The Patent Office is also respectfully
5 requested to more fully address the elements recited in the dependent claims. (Note
6 MPEP § 707.07(d): “*A plurality of claims should never be grouped together in a*
7 *common rejection, unless that rejection is equally applicable to all claims in the*
8 *group.*”)

9 Finally, paragraph No. 18 of the Office Action indicates that the Patent Office
10 continues to ignore the claim elements that are structured using the “configured to”
11 construction. The Applicant’s rebuttal of this stance is fully set forth in the June 10, 2005
12 Response, which is incorporated here by reference. In brief, the “configured to” language
13 is permissible at least because:

14 • MPEP § 2173.05(g) states that there “is nothing inherently wrong with defining
15 some part of an invention in functional terms. Functional language does not, in and of
16 itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA
17 1971).”

18 • The “configured to” phraseology, when used in computer-related inventions,
19 refers to physical elements that must be given weight in the examination of the claims.
20 Namely, in this type of invention, a claim element which recites “XYZ module
21 configured to perform function ABC” reflects a structural difference, as this language
22 ultimately refers to the tangible logic used to implement this function. Consider *In re*
23 *Alappat*, 33 F.3d 1526, at 1545 (Fed. Cir. 1994) (“We have held that programming
24 creates a new machine, because a general purpose computer in effect becomes a special
25 purpose computer once it is programmed to perform particular functions pursuant to

instructions from program software”). Note also *In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) (data structures designed to permit computer to run more efficiently “impart a physical organization on the information stored in memory”). While these two decisions pertain to the proper application of 35 U.S.C. § 101, the conclusions reached therein also have obvious bearing on what claim elements should be given weight in the context of making prior art rejections under § 102 and § 103.

- In the previous Response, the Applicant submitted compelling evidence that, even in the Examiner’s own group, many patents have issued that include system claims that use the “configured to” claim phraseology, suggesting that this language is deemed acceptable to the Patent Office.

In paragraph No. 19 (on page 9) of the Office Action, the Patent Office states, “The Examiner maintains his position regarding conditional language such as ‘configured to.’” First, there is nothing conditional about saying that a component is configured to perform a certain act, as this language states that the component unconditionally includes a prescribed property. To draw an analogy, if a car is customized in a certain way, the car has been unconditionally altered to assume a certain characteristic. Second, the Patent Office has provided no authority to support its position that the phrase “configured to” is conditional language.

Regarding the Presentation of New Claims

This Response adds new independent claims 49 and 50. These claims are presented to supplement the Applicant’s above-described response to the 35 U.S.C. § 101 rejection. Namely, these two claims use different claim drafting strategies to express the statutory nature of the invention. Otherwise, these two claims recite related elements to

1 that recited in claim 1, and therefore are allowable over Bowman-Amuah and Garg for
2 reasons similar to those presented above.

3
4 *Regarding Miscellaneous Issues*

5 The Office Action contains a large amount of seemingly general-purpose legal
6 analysis regarding claim interpretation and other legal issues. Applicant does not
7 concede to any PTO-dictated redefinition of the claim language which may
8 inappropriately restrict these claims to "special" or idiosyncratic interpretations of the
9 claims that were not intended by Applicant. Applicant does not concede to any other
10 abdication of rights which may stem from any position expressed in the Office Action's
11 form paragraphs.

12
13 *Conclusion*

14 The arguments presented above are not exhaustive; Applicant reserves the right to
15 present additional arguments to fortify its position. Further, Applicant reserves the right
16 to challenge the prior art status of one or more documents cited in the Office Action.

1 All objections and rejections raised in the Office Action having been addressed, it
2 is respectfully submitted that the present application is in condition for allowance and
3 such allowance is respectfully solicited. The Examiner is urged to contact the
4 undersigned if any issues remain unresolved by this Amendment.
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7 Respectfully Submitted,

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9 Dated: 3/23/2006

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